

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:
Brian FEENEY et al.

Serial No. 09/248,595

Group Art Unit: 3711

Filed: February 11, 1999

Examiner: M. Aryanpour

For: GAME BALL WITH IMPROVED MOISTURE RESISTANCE

Commissioner For Patents
Washington, DC 20231

ATTENTION: Board of Patent Appeals and Interferences

Honorable Sir:

RECEIVED
2002 JAN 15 PM 4:01
BOARD OF PATENT APPEALS
AND INTERFERENCES

REPLY BRIEF

RECEIVED
JAN 17 2002
TECHNOLOGY CENTER R3700

REPLY BRIEF

The point headings in this Reply Brief correspond to the point headings in Appellants' previously filed Brief.

A. THE EXAMINER HAS FAILED TO CORRECTLY CONSTRUE THE PENDING CLAIMS WITHIN THE REQUIREMENTS OF RELEVANT LEGAL PRECEDENT.

1. THE EXAMINER HAS NOT CONSIDERED THE ENTIRETY OF APPELLANTS' CLAIMS.

In section VII(A)(1) of their Brief, Appellants discussed the Examiner's failure in any of the Office Actions to construe the entirety of their claimed invention. The Examiner's Answer fails to address this aspect of Appellants' arguments with any specificity, if at all, relying instead on repetition of the Examiner's previous inadequate arguments.

C. THE EXAMINER HAS FAILED TO ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS AGAINST APPELLANTS' PENDING CLAIMS.

1. THERE IS NO SUGGESTION OR MOTIVATION, EITHER IN THE REFERENCES THEMSELVES OR IN THE KNOWLEDGE GENERALLY AVAILABLE TO ONE OF ORDINARY SKILL IN THE ART, TO COMBINE THE WALTERS AND FRIESE REFERENCES IN THE MANNER SUGGESTED BY THE EXAMINER.

a. THE FRIESE REFERENCE DOES NOT TEACH OR SUGGEST PRODUCTION OF THE LEATHER PROPERTIES REQUIRED BY THE WALTERS REFERENCE.

In section VII(C)(1)(a) of their Brief, Appellants discussed the fact that the Examiner's cited Walters reference requires leather having certain characteristics, i.e. tackiness, for use therein.

Appellants in that section go on to show that the cited reference of Friese does not teach production of leather having the tackiness characteristic required by the Walters reference. In fact, as discussed in that section and supported by the Appendix attached to Appellants' Brief, the Friese reference teaches production of leather having "lardy" characteristics, which characteristics are opposite of those required by the Walters' reference. The Examiner's Answer fails to address this aspect of Appellants' argument or to discuss this aspect of the cited references.

C. THE EXAMINER HAS FAILED TO ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS AGAINST APPELLANTS' PENDING CLAIMS.

- 1. THERE IS NO SUGGESTION OR MOTIVATION, EITHER IN THE REFERENCES THEMSELVES OR IN THE KNOWLEDGE GENERALLY AVAILABLE TO ONE OF ORDINARY SKILL IN THE ART, TO COMBINE THE WALTERS AND FRIESE REFERENCES IN THE MANNER SUGGESTED BY THE EXAMINER.**
- b. THE EXAMINER HAS FAILED TO PROVIDE A "CONVINCING LINE OF REASONING" AS TO WHY IT WOULD BE OBVIOUS TO COMBINE THE FRIESE AND WALTERS REFERENCES.**

In section VII(C)(1)(b) of their Brief, Appellants discussed the fact that the Examiner had failed to provide the legally required "convincing line of reasoning" as to why it would be obvious to combine the references of Friese and Walters. In response, the Examiner's Answer at page 7, lines 10-13 states: "[i]n this case, combining a method of producing a better waterproof leather with a known waterproof leather game ball in order to increase resistance to moisture absorption would have been obvious to one of skilled [sic] in this art with the references before him to gain

the advantages of the better leather." Appellants remain unclear as to the exact reasoning hypothesized in the Examiner's above statement.

If the Examiner is proposing substitution of leather processed as taught by Walters with leather processed as taught by Friese, then as discussed in Appellants' Brief, leather tanned by the process of Friese has inferior moisture resistance as compared to leather processed as taught by Walters. Thus, a person skilled in the art would understand the Friese treated leather to be INFERIOR in terms of moisture resistance to the Walters treated leather and not "better" as asserted by the Examiner. The Examiner's Answer offers NO support in the cited references or the art to support the statement that the leather of Friese is "better" than the leather of Walters.

If the Examiner is proposing using leather initially processed using the process of Friese in the process of Walters, then the Examiner has yet to explain how, in an unpredictable art, a person of ordinary skill can start with the "soft" and "lardy" leather of Friese; process that leather with the only materials taught in Walters; avoid the problems recited by Walters at, for example, column 4, lines 48-65; and achieve the tackiness and moisture resistance properties disclosed by Walters.

In fact, the coating materials recited in Walters form films over the coated surface on application (see, Walters at, for example, column 6, lines 22-26 and column 8, lines 1-7). Thus, it is reasonable to conclude that treatment of the leather prior to coating with the materials of Walters will have no effect on moisture resistance of the resulting Walters surface film. Thus, use of leather treated as disclosed in the Friese reference would not necessarily be "better" than use of any other leather in the

Walters process. The Examiner's Answer offers NO support in the cited references or the art to support the statement that the leather of Friese is "better" than the leather of Walters.

The Examiner's Answer fails to provide a "convincing line of reasoning" as to why it would be obvious to combine the references of Walters and Friese and further fails to address Appellants' arguments concerning the lack of suggestion to combine the references of Walters and Friese

C. THE EXAMINER HAS FAILED TO ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS AGAINST APPELLANTS' PENDING CLAIMS.

2. THE WALTERS AND FRIESE REFERENCES, SINGLY OR IN COMBINATION, DO NOT PROVIDE THE LEGALLY REQUIRED REASONABLE EXPECTATION OF SUCCESS REQUIRED TO ESTABLISH A *PRIMA FACIE* OBVIOUSNESS REJECTION.

In section VII(C)(2) of their Brief, Appellants discussed the fact that the Examiner's cited references of Walters and Friese, singly or in combination, do not provide the legally required expectation of success required to establish a *prima facie* obviousness rejection. The Examiner's Answer fails to address Appellants' arguments concerning the lack of a reasonable expectation of success to combine the references of Walters and Friese

C. THE EXAMINER HAS FAILED TO ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS AGAINST APPELLANTS' PENDING CLAIMS.

3. EVEN IF THE WALTERS AND FRIESE REFERENCES ARE IMPROPERLY COMBINED, THE COMBINED REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE FEATURES OF THE PENDING CLAIMS.

In section VII(C)(3) of their Brief, Appellants discussed the fact that the Examiner's cited references of Walters and Friese, singly or in combination, do not teach or suggest all of the features of Appellants' pending claims required to establish a *prima facie* obviousness rejection. In reply, the Examiner appears to assert (Examiner's Answer, page 7, lines 14-19) that the alleged features are not recited in the claim. As support for this assertion the Examiner states: "[a]lthough the claims are interpreted in light of the specification, limitations from the specification are not read into the claims." However, as discussed by Appellants in section VIII(A)(1)(a) of their Brief, there is clear legal precedent for using the definition of "rain test" recited in Appellants' specification to interpret the recitation of "rain test" in Appellants' pending claims.

Further, the Examiner stated "[i]f the prior art structure is capable of performing the intended use, then it meets the claim." See Examiner's Answer, page 8, lines 4-5. As discussed in section VII(C)(3) of Appellants' Brief, the game ball of Walters and the proposed combination of the Examiner are NOT capable of meeting Appellants' pending claims as properly construed.

The Examiner's Answer fails to indicate where each of the features of Appellants' pending claims can be found in the cited references.

D. WHEN CONSIDERED AS A WHOLE THE WALTERS REFERENCE AND THE FRIESE REFERENCE TEACH AWAY FROM EACH OTHER.

In section VII(D) of their Brief, Appellants discussed the fact that the Examiner's cited Walters reference requires leather having certain characteristics, i.e. tackiness, for use therein. That section goes on to show that the Walters reference teaches away from use of leather tanned using the Friese process because the Friese process tanned leather is described as "soft" and "lardy". In fact, as discussed in that section and supported by the Appendix attached to Appellants' Brief, the Friese reference teaches production of leather having characteristics that are contrary to the characteristics required by the Walters reference. The Examiner's Answer fails to address this aspect of Appellants' argument.

E. THE WALTERS AND FRIESE REFERENCES, SINGLY OR IN COMBINATION, DO NOT TEACH OR SUGGEST ALL OF THE FEATURES OF PENDING CLAIM 5.

In section VII(E) of their Brief, Appellants discussed the fact that claim 5 recites in pertinent part: "wherein the lining is coated with at least one water resistant polymeric material selected from the group consisting of epoxy, polyester and urethane materials." The Office Action mailed on April 25, 2001 states on page 3: "[r]egarding claims 5 and 6, Walters shows a vinyl-impregnated polyester fabric containing two or three plies. Although applicant has removed the 'vinyl' limitation from the claim, still a 'polyester' fabric is vinyl-impregnated, and it is well known to use a lining made from the groups consisting of epoxy, polyester and urethane materials."

The Examiner's Answer fails to provide any support for the stated assertions that "still a 'polyester' fabric is vinyl-impregnated" or "it is well known to use a lining made from the groups consisting of epoxy, polyester and urethane materials."

F. THE WALTERS AND FRIESE REFERENCES, SINGLY OR IN COMBINATION, DO NOT TEACH OR SUGGEST ALL OF THE FEATURES OF PENDING CLAIM 6.

In section VII(F) of their Brief, Appellants discussed the fact that claim 6 recites in pertinent part: "wherein the lining comprises a fiber reinforced sheet-like material with water resistant properties." The Office Action mailed on April 25, 2001 states on page 3: "[r]egarding claims 5 and 6, Waiters shows a vinyl-impregnated polyester fabric containing two or three plies. Although applicant has removed the 'vinyl' limitation from the claim, still a 'polyester' fabric is vinyl-impregnated, and it is well known to use a lining made from the groups consisting of epoxy, polyester and urethane materials."

The Examiner's Answer fails to provide any support for the stated assertions that "still a 'polyester' fabric is vinyl-impregnated" or "it is well known to use a lining made from the groups consisting of epoxy, polyester and urethane materials."

G. THE EXAMINER HAS RESORTED TO IMPERMISSIBLE HINDSIGHT TO ASSERT THAT APPELLANTS' CLAIMS ARE OBVIOUS OVER THE WALTERS AND FRIESE REFERENCES.

In section VII(G) of their Brief, Appellants discussed the Examiner's impermissible use of hindsight to assert a *prima facie* case of obviousness. The Examiner's Answer fails to address this argument.

Respectfully submitted,

Brian Feeney et al

By 

James E. Piotrowski
Registration No. 43,860
Alix, Yale & Ristas, LLP
Attorney for Appellants

Date: December 28, 2001

750 Main Street – Suite 1400
Hartford, CT 06103
(860) 527-9211
Atty. Docket No.: SPALD/216/US

G:\1\wpdocs\Jep\Spalding\spald 216\spald 216.us.12-01 reply brief.doc